

### REMARKS

Applicants respectfully request entry of the amendments and remarks submitted herein. Claim 13 has been amended herein to correct a typographical error.

Claims 1-7 and 9-31 are currently pending. Applicants respectfully request reconsideration of the present application.

#### The 35 U.S.C. §103 Rejections

Claims 1-2, 6, 9-10, and 12-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sakuma et al. (WO 2003/067999). Specifically, the Examiner asserted that Sakuma discloses an oil/fat powder that includes a fat (glycerides), one or more powder-forming bases such as carbohydrates, proteins or peptides, and water. The Examiner alleged that it would have been obvious to one of ordinary skill in the art to “select a combination of ingredients such as starch n-octenyl succinate and another starch to obtain different nutritional factors, taste, texture and flavor” (OA at page 2), and further alleged that it would have been obvious to one of ordinary skill in the art to “vary the amounts of these ingredients depending on the nutrition, flavor and texture wanted as long as they fall within the range of 20% to 84.8%” (OA at page 3). This rejection is respectfully traversed.

Applicants respectfully submit that this is a classic case of hindsight, which is still improper. The *KSR* Court, quoting *Graham* (383 U.S., at 36), stated that the “Supreme Court has ‘warn[ed] against ‘temptation to read into the prior art the teachings of the invention in issue’ and instruct[ed] courts to ‘guard against slipping into the use of hindsight’.” (*KSR International Co. v. Teleflex Inc.*, 127 S. Ct., at 1742 (2007)). In addition, the *KSR* Court stated that a “factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.” (*KSR* at 1742).

Sakuma does not teach or suggest the presently claimed composition recited in independent claim 1, which is directed toward a combination of starch n-octenyl succinate and whey protein for use in bakery products as a replacement for egg. On the other hand, Sakuma discloses a composition of water, glycerides, and one or more powder bases such as carbohydrates, proteins, or peptides. Significantly, none of the compositions that were actually

exemplified in Sakuma include either whey protein or starch n-octenyl succinate, as is required by independent claim 1. Sakuma indicates that, of the starches disclosed, dextrin is preferred, and all of the compositions exemplified in Sakuma contain either dextrin or maltodextrin. See, for example, page 12, lines 3-8, and Tables 3, 4 and 5. In addition, Sakuma teaches selecting components based upon dispersibility rather than baking properties and, notably, the only baking products disclosed in Sakuma contain whole egg. See, for example, Examples 4 and 7 on pages 41 and 42. The Examiner has failed to identify any disclosure in Sakuma that would have prompted one of skill in the art to develop the claimed egg substitute compositions that include starch n-octenyl succinate and whey protein.

For at least these reasons, a person of ordinary skill in the art reading Sakuma at the time of filing would not have found it obvious to make the presently recited compositions. As such, the present claims are patentable over Sakuma. In light of the above, Applicants respectfully request that the rejection of claims 1-2, 6, 9-10 and 12-14 under 35 U.S.C. §103(a) be withdrawn.

Claims 1-4, 6-7, 9-10, 12-25, and 27-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sarneel et al. (WO 2004/084640) in view of Sakuma et al. Specifically, the Examiner asserted that Sarneel discloses a multipurpose dry mix, and that Sakuma discloses a powder that can include whey protein. The Examiner alleged that it would be obvious to one of ordinary skill in the art to select a known material on the basis of its suitability to be in processed foods and to use the dry mix of Sarneel and the oil/fat powder of Sakuma to obtain the desired food product. This rejection is respectfully traversed.

The remarks above regarding the improper use of hindsight are reiterated with respect to this rejection. In the present rejection, the Examiner combined Sarneel, which discloses compositions that include fat, proteins, and carbohydrates such as starch, starch hydrolysates, emulsifying starch or dextrin, with Sakuma, which is discussed above. Applicants note that eggs and fat are essential ingredients in the Sarneel compositions, and the compositions of Sarneel contain only about 1-10% w/w starch n-octenyl succinate. As acknowledged by the Examiner, Sarneel does not teach or suggest a composition that includes starch n-octenyl succinate within the ranges recited in the present claims (OA at page 4).

“A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” *KSR* at 401. In the present case, the Examiner simply combined Sarneel, which discloses starch n-octenyl succinate, with Sakuma, which discloses whey protein, and asserted that one of ordinary skill would arrive at the claimed amounts to obtain “desired nutritional factor, taste, texture and flavor”. However, the Supreme Court has also stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” (*KSR* at 1727, quoting *In re Kahn*, 441 F.3d 997, 988 (Fed. Cir. 2006)).

For at least these reasons, a person of ordinary skill in the art reading Sarneel in combination with Sakuma at the time of filing would not have found it obvious to make the presently recited compositions. As such, the present claims are patentable over the combination of references and, in light of the above, Applicants respectfully request that the rejection of claims 1-4, 6-7, 9-10, 12-25, and 27-31 under 35 U.S.C. §103(a) be withdrawn.

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sarneel et al. in view of Sakuma et al. and further in view of Gisaw et al. (U.S. Patent No. 6,558,730). Specifically, the Examiner alleged that it would have been obvious to one of ordinary skill in the art to combine Sarneel and Sakuma as described above with the n-octenyl succinate taught by Gisaw. This rejection is respectfully traversed.

As indicated above, independent claim 1 is not obvious over Sakuma alone or the combination of Sarneel and Sakuma. As such, claim 5, which depends from claim 1, also is not obvious. “Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.” *In re Fine*, 837 F.2d 1071 (C.A. Fed. 1988), citing *Hartness Int'l, Inc. v. Simplimatic Eng'g Co.*, 819 F.2d 1100, 1108, 2 USPQ2d 1826, 1831 (Fed.Cir.1987); *In re Abele*, 684 F.2d 902, 910, 214 USPQ 682, 689 (CCPA 1982); and *In re Sernaker*, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed.Cir.1983). Accordingly, Applicants respectfully request that the rejection of claim 5 under 35 U.S.C. §103(a) be withdrawn.

Claims 11 and 26 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Sarneel in view of Takashima (US 2001/0055638). Specifically, the Examiner alleged that Sarneel teaches a dry mixture of ingredients and that Takashima teaches adding thermocoagulation proteins such as whey protein. The Examiner further alleged that it would have been obvious to one of ordinary skill in the art to include whey protein in order to avoid shrinkage during baking.

This rejection is respectfully traversed. The arguments put forth herein regarding the improper use of hindsight and the improper combination of individual elements from the prior art apply to the present rejection. For example, the Examiner combined Sarneel for its disclosure of starch n-octenyl succinate with Takashima for its disclosure of whey protein. Significantly, however, Sarneel is silent regarding whey protein (OA at page 10), and Takashima does not disclose starch n-octenyl succinate. Notably, Takashima discloses using 18% w/w whey protein (see, for example, paragraph [0070] in Example 6), while pending independent claim 11 requires only 0.1%-7% whey protein.

Neither of the cited references contains disclosure that would prompt one of ordinary skill in the art to combine the recited ingredients in the recited amounts. In view of the remarks herein, Applicants respectfully request that the rejection of claims 11 and 26 under 35 U.S.C. §103(a) be withdrawn.

#### Double Patenting

Claims 11 and 26 stand rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 4, 8, and 17 of U.S. Patent No. 6,663,909 in view of Takashima.

Applicants respectfully request that this rejection be held in abeyance until allowable subject matter is found. At that time, Applicant will consider submitting an appropriate Terminal Disclaimer.

#### CONCLUSION

In light of the remarks herein, Applicants submit that all claims are in condition for allowance, which action is respectfully requested. The Examiner is invited to telephone the

Applicant : Frans Johan Sarneel et al.  
Serial No. : 10/568,216  
Filed : February 18, 2006  
Page : 10 of 10

Attorney's Docket No.: 19790-0006US1 / CER03-0018

undersigned if such would expedite prosecution. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

/December 4, 2009/

/M. Angela Parsons/

Date: \_\_\_\_\_

\_\_\_\_\_  
M. Angela Parsons, Ph.D.  
Reg. No. 44,282

Fish & Richardson P.C.  
3200 RBC Plaza  
60 South Sixth Street  
Minneapolis, Minnesota 55402  
Telephone: (612) 335-5070  
Facsimile: (877) 769-7945